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10/700,215	11/03/2003	Richard G. Sevier	200311063-1	3095

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EXAMINER
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STOREY, WILLIAM C

ART UNIT	PAPER NUMBER
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2625

NOTIFICATION DATE	DELIVERY MODE
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09/18/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/700,215	<b>Applicant(s)</b> SEVIER, RICHARD G.	
	<b>Examiner</b> WILLIAM C. STOREY	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,5-10,20,24-29,39 and 50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5-10,20,24-29,39 and 50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Note to Applicant***

The examiner notes that 3 months after the filing of the most recent non-final office action, a notice of appeal was entered into the system. As the notice of appeal in response to a non-final action with new grounds of rejection is improper, and since an extension of time as required to file the non-final amendment after the entrance of the notice of appeal (entered 3 months after the non-final action) was never filed, the examiner takes the applicant in good faith to have made an unintended mistake, and will treat the submitted amendment as a non-final amendment, rather than an amendment after appeal, the amendments of which may be subject to dismissal. In addition, due to the complex situation, the examiner has provided the applicant the benefit of the accelerated examination associated with an amendment after appeal.

### ***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 5-8, 20, 24-27, 39, 50 are rejected under 35 U.S.C. 103(a) as being obvious over Connolly (US 6169873).

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Regarding claim 1, Connolly discloses scanning that may scan up to two sides, and that analysis of a page's pixels is performed, and that the scanner provides images of the sides of sheets intended for image transfer (fig. 1, col. 5, lines 13-29, lines 54-67). It is well known to those of ordinary skill in the art to obtain digital images from scans for image transfer (obtaining a first digital image of a first side of a physical object (paper)). The physical object is a first of an ordered set of physical objects (fig. 1); examining the first digital image to determine if it is substantially blank (col. 6, lines 28-31. Since a determination is done to see if images appear on one or two sides of first pages, it is inherent that the first digital image be determined if it is substantially blank in this context (col. 5, lines 54-63);

Although Connolly did not distinctly disclose checking only one image for face orientation, and then making the assumption for the rest of the sheets in the stack. Connolly disclosed fig. 2, col. 6, lines 12-67, col. 7, lines 1-20. Connolly disclosed checking 3 pages as a preferred embodiment before a determination of a page orientation was made. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide checking only one image for face orientation, and then making the assumption for the rest of the sheets in the stack for the purpose of increasing speed. The checking of additional pages is an improvement that allows for error reduction and the system could easily be implemented by only checking one page.

In addition, the current invention discusses simplex or duplex detection whereas the instant claim does not particularly refer to such a distinction. Col. 5, lines 41-44 disclose

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even for duplex scanning one side of a sheet of duplex documents may be scanned at a time. It would have been obvious to implement the well known method of duplex scanning in order to increase speed without having to preclude possible information on a second side of a sheet.

if the first side is not substantially blank, obtaining a first set of digital images, each digital image of the first set being a digital image of a first side of a physical object of the ordered set of physical objects (col. 5, lines 41-44, col. 7, lines 5-10, previous discussions. Inherently a stack of sheets is ordered.), and, sending the first set of digital images for processing (col. 7, lines 13-15); and if the first digital image is substantially blank, obtaining a second set of digital images, each digital image of the second set being a digital image of a second side of a physical object of the ordered set of physical objects, and sending the second set of digital images for processing (fig. 2, col. 6, lines 12-67, col. 7, lines 1-20, and similar to previous discussion for other side).

In addition, Connolly discloses fig. 2, col. 6, lines 54-64, col. 7, lines 5-10. This shows that there is a pause after the first side is examined for determination of blankness, before a confirmation to go ahead and use the images on the reverse side (obtain second set of digital images). Although Connolly did not distinctly disclose obtaining the second set of digital images *only* if the first digital image is substantially blank, it would have been obvious to provide removing the improvement of duplex determination or scanning in order that obtaining the second set of digital images occurs *only* if the first digital image is substantially blank for the purpose of allowing the invention to be easier to be less complicated. Connolly teaches that a user may input

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that all pages are to simplex. If the system looks for all pages to be simplex, it would be obvious that when a first page is scanned, if the first side is substantially blank, to check the second side for image data. However, if the first side is not substantially blank, then, of course, the first side would be taken as the side of the simplex page, and the second side would not need to be checked since the pages are simplex (image data on one side). Similarly, if the second side is not substantially blank and the first side was, then, of course, the second side would be taken as the side of the simplex page. A simplex print is known to have image data printed on only one side. It would have been obvious from the discussion, understanding in the art, and the teachings of Connolly to set the side of the page with image data as the simplex side for obtaining, thus providing greater flexibility and simplicity from the previous discussion.

Regarding claim 5, the claim inherits everything as applied above for claim 1. Although Connolly did not distinctly disclose discarding the first digital image if is substantially blank, Connolly disclosed col. 7, lines 53-55. It would have been obvious to one of ordinary skill at the time the invention was made to provide discarding the first digital image if is substantially blank for the purpose of the output of the scanner not requiring as much space or transmission time.

Regarding claim 6, the claim inherits everything as applied above for claim 1. It was disclosed previously scanning the sheets in order to generate images, thus, reading on the claim.

Regarding claim 7, the claim inherits everything as applied above for claim 1. Although Connolly did not distinctly disclose sending the not substantially blank side of

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images to be printed, Connolly disclosed col. 5, line 19, line 67, claim 7. It would have been obvious to one of ordinary skill at the time the invention was made to provide sending the not substantially blank side of images to be printed for the purpose of having an extra copy of information in case the first copy gets lost.

Regarding claim 8, the claim inherits everything as applied above for claim 1. Although Connolly did not distinctly disclose sending the not substantially blank side of images to be facsimile transmitted, Connolly disclosed col. 7, lines 37-41, col. 5, line 15. It would have been obvious to one of ordinary skill at the time the invention was made to provide sending the not substantially blank side of images to be facsimile transmitted for the purpose of having allowing someone far away to see the printed information.

Regarding claim 20, the claim is rejected based upon similar reasoning as applied above for claim 1. Changing the claim from one category of invention to another does not make the claim patentably distinct.

Regarding claim 24, the claim is rejected based upon similar reasoning as applied above for claim 5. Changing the claim from one category of invention to another does not make the claim patentably distinct.

Regarding claim 25, the claim is rejected based upon similar reasoning as applied above for claim 6. Changing the claim from one category of invention to another does not make the claim patentably distinct.

Regarding claim 26, the claim is rejected based upon similar reasoning as applied above for claim 7. Changing the claim from one category of invention to another does not make the claim patentably distinct.

Regarding claim 27, the claim is rejected based upon similar reasoning as applied above for claim 8. Changing the claim from one category of invention to another does not make the claim patentably distinct.

Regarding claim 39, the claim is rejected based upon similar reasoning as applied above for claim 1. The system simply provides structure for the method of claim 1 and is not patently distinct; thus, claim 39 is rejected for the same reasons as stated above in the rejection of claim 1. Specifically, Connolly discloses a system including a scanning device (col. 5, lines 13-29) which may read on claimed image manager and content module.

Regarding claim 50, the claim is rejected based upon similar reasoning as applied above for claim 39. The “means for” providing the functions in the claim may be read upon by the system including the scanning device.

4. Claims 9 & 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Connolly as applied to claims 1 and/or 20 above, and further in view of Garcia (US Publication Application Publication 2003/0048470).

Regarding claim 9, the claim inherits everything as applied above for claim 1. Although Connolly did not distinctly disclose sending images to be email transmitted, Connolly disclosed col. 7, lines 37-41, col. 5, line 15 which show long distance image data transfer capabilities.

In addition, in a similar field of endeavor, Garcia discloses a multi-function peripheral, including a scanning function. Garcia describes scanning documents to



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create a digital image of a document and an email function that permits electronic mailing of the digital image, as disclosed in paragraph 29.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Connolly by specifically providing sending images to be email transmitted, as taught by Garcia, for the purpose of allowing someone far away to see the printed information that was scanned by the system.

Regarding claim 28, the claim is rejected based upon similar reasoning as applied above for claim 9. Changing the claim from one category of invention to another does not make the claim patentably distinct.

5. Claims 10 & 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Connolly as applied to claims 1 and/or 20 above, and further in view of Okubo (US Patent Application Publication 2005/0200903) and Nakano (US Patent Application Publication 2004/0145770).

Regarding claim 10, Connolly discloses everything claimed as applied above in claim 1.

However, Connolly did not disclose outputting image data to a computer. In a similar field of endeavor discloses a system that eliminates blank pages from image output. In addition, Okubo discloses that the data output unit 17 may send the image data to an external device such as a personal computer, as disclosed in paragraph 30.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Connolly by specifically providing outputting data

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to a computer as taught by Nakano, for the purpose of allowing for more user interaction with the images and the ability to store the images for later use.

However, Connolly and Okubo do not distinctly archival of the image file. In a similar field of endeavor, Nakano discloses archiving of digital images in a multi-function device system. Nakano discloses copying or moving a digital image to an archive directory on a desktop computer, server, or removable medium, as disclosed in paragraph 25.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Connolly and Okubo by specifically providing archiving of digital images, as taught by Nakano, for the purpose of allowing better management of digital images, as disclosed in paragraph 4.

Regarding claim 29, the claim is rejected based upon similar reasoning as applied above for claim 10. Changing the claim from one category of invention to another does not make the claim patentably distinct.

### ***Response to Arguments***

6. Applicant's arguments filed 8/21/08 have been fully considered but they are not persuasive.

Regarding the discussion for the claims, the substance of the applicant's proposal regarding the claim(s) surrounds the idea that Connolly did not teach "only if the first digital image is substantially blank, obtaining a second digital image of a second side of the physical object, the physical object being the first of the ordered set of physical objects and examining the second digital image to determine if it is

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substantially blank.” This added limitation comes straight from newly-canceled claims, like claim 4. However, the previous rejection of this limitation never asserted that Connolly taught the limitation, only that it would have been obvious to provide what is discussed in the limitation. Yet, the applicant never addressed the grounds of the previous rejection of this limitation, and consequently, the examiner has no choice but to maintain the previous rejection. The applicant's allegation that two lines of Connolly (col. 6, lines 31-33) do not specifically disclose the limitation is not sufficient to prove that it would not have been obvious to one of ordinary skill in the art to provide such a limitation. In addition, the only evidence that the applicant provides merely mentions that the system of Connolly "can" scan both sides, not that the system is incapable of only scanning one side. The ability to scan both sides in the scenario of Connolly is an improvement over the scanning of only one side, as it provides error checking against a user input. Surely, such an enhancement does not preclude the obviousness of the limitation, as previously discussed with regard to claim 4. Therefore, even as this weakens the already deficient, and truly limited (if any), rationale with regard to the limitation newly added to claim 1 and previously rejected in claim 4, the complete absence of any addressal, or even acknowledgement, of the previous grounds of obviousness rejection, mandates that the examiner maintain the previous rejection.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM C. STOREY whose telephone number is (571)270-3576. The examiner can normally be reached on Monday - Friday Eastern Standard Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Y. Poon can be reached on (571) 272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William C Storey/  
Examiner, Art Unit 2625

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